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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 09/421,332 | 10/18/99 | SAKAI | K 0557-4628-2- <i>ahn</i> |
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EXAMINER

PHAN, J

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

08/28/01

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/421,332

Applicant(s)
Sakai et al

Examiner
James Phan

Art Unit
2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 30, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-15 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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DETAILED ACTION***Claim Rejections - 35 USC § 112***

1. The rejection of claims 1-7 and 10-15 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification, made in paper no. 15, page 2, paragraph #3, is repeated. Applicants have traversed the rejection by arguing that the office action has not pointed to any express statements in the specification that are commensurate with the facts of the cited cases, i.e. SciMed Life Systems, Inc., v. Advanced Cardiovascular Systems, Inc., Slip Opinion, Appeal No. 99-1499 (Fed. Cir. March 14, 2001) and The Gentry Gallery Inc. v. The Berkline Corp., 45 USPQ2d 1498 (Fed. Cir. 1998). This argument has not been found persuasive because the disclosure of the present application does not disclose any embodiments other than the only one embodiment, ^A(that is disclosed and illustrated in Figs. 1A-9), which does not support for claims 1-7 and 10-15.

Applicants also argue that the entire specification should be read in light of the fourth full paragraph of column 12 that expressly states that the specification is not to be interpreted as limiting the scope of the invention. Applicants cite In Reiffin v. Microsoft Corp., 54 USPQ2d 1915 (Fed. Cir. 2000) to support their argument. Applicants' argument has been fully considered; however, there is **no teaching or suggestion** in the applicants' disclosure that **the range of the magnification** of the multi-beam optical

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scanner specified in independent claims 1 and 13-15 **would be satisfied without a coupling lens.**

Applicants further argue that numerous figures in applicants' specification illustrated that applicants were in possession of the claimed invention at the time of filing and request that the examiner must provide reasons why one of ordinary skill in the art would not consider the description sufficient. In response the examiner states that the specification is not sufficient because it does not teach or suggest that **the range of the magnification** of the multi-beam optical scanner specified in independent claims 1 and 13-15 **would be satisfied without a coupling lens.**

2. The rejection of claims 1-7 and 10-15 under 35 U.S.C. 112, first paragraph, as failing to be supported by an enabling disclosure, made in paper no. 15, page 3, paragraph #4, is repeated. Applicants have traversed the rejection by arguing that the submitted Supplemental Declaration illustrates that the claimed invention is supported by an enabling disclosure. In response the examiner states that no weight is given to the Supplemental Declaration because it does not show that the magnification range of a multi-beam optical scanner which does not include a coupling lens would be the same as that of a multi-beam optical scanner which includes a coupling lens.

3. The rejection of claims 1-7 and 10-15 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, made in paper no. 15, page 3, paragraph #5, is repeated. Applicants have traversed the rejection by arguing that the reliance on Mayhew is misplaced and thus, this rejection should be withdrawn. In response the

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examiner states that ^Acase might be misplaced; but the fact is that applicants fail to show that the claimed magnification range could be obtained without the use of a coupling/collimate lens.

4. The rejections of claims 1-7 and 10-15 under 35 USC 102(a) and 103 made in paper no. 15 are withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Phan whose telephone number is (703) 308-

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4810. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Phan, J.
Aug. 24, 2001


James Phan
Primary Examiner